

ESTTA Tracking number: **ESTTA341996**

Filing date: **04/12/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|------------------------|--|
| Proceeding | 91185325 |
| Party | Plaintiff La Senza Corporation |
| Correspondence Address | George W. Lewis Jacobson Holman PLLC 400 7th Street NW Washington, DC 20004 UNITED STATES mcuccias@jhip.com, trademark@jhip.com, joyhenart@jhip.com |
| Submission | Other Motions/Papers |
| Filer's Name | Matthew J. Cuccias |
| Filer's e-mail | mcuccias@jhip.com, trademark@jhip.com, joyhenart@jhip.com, glewis@jhip.com |
| Signature | /Matthew J. Cuccias/ |
| Date | 04/12/2010 |
| Attachments | I-5837 Reply Brief on EOT.pdf (25 pages)(565777 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

LA SENZA CORP.,

Opposer

vs.

OLYMPIC MOUNTAIN AND MARINE
PRODUCTS, INC.,

Applicant.

Opposition No. 91185325

**Opposer's Brief in Further Support of
Motion to Extend Opposer's Deadline to Respond to
Applicant's Motion for Leave to Amend**

On March 15, 2010, Opposer filed an extension request, entitled "Motion to Extend Opposer's Deadline to Respond to Applicant's Motion for Leave to Amend" ("Extension Request"). The Extension Request seeks a one week extension of the deadline for Opposer to respond to Applicant's second motion to amend ("Second Motion to Amend"), until March 22, 2010.

On March 21, 2010, Applicant filed a brief in opposition to the Extension Request, entitled "Memorandum in Opposition to Opposer's Motion to Extend Deadline to Respond" ("Extension Request Opposition").

On March 22, 2010, Opposer filed its response to the Second Motion to Amend, consistent with the deadline requested in the Extension Request.

By way of this paper, Opposer responds to the Extension Request Opposition.

Introduction

Opposer submits that it reasonably relied on the parties' course of conduct in believing that Applicant would consent to a further extension of the deadline to respond to the Second Motion to Amend, while Opposer's settlement proposal was pending with Applicant. In any event, Opposer has established good cause for its request for a one week extension of that deadline.

Moreover, there is no evidence of bad faith or lack of diligence by Opposer, an abuse of the privilege of extensions by Opposer, or prejudice to Applicant arising from a one week extension (indeed, Opposer would be prejudiced by its denial). Accordingly, Opposer respectfully requests that the Board grant its request for a one week extension of the deadline to respond to the Second Motion to Amend.

Discussion

Applicant's Extension Request Opposition introduced a number of emails between counsel (including, un-redacted settlement proposals¹). However, rather than controvert Opposer's position, Opposer respectfully submits that these exhibits offer additional support for Opposer's request for a one week extension, and directly controvert several assertions made in Applicant's Extension Request Opposition.

¹ Settlement communications inherently are confidential, and should not be disclosed to the public without consent of the involved parties. Without Opposer's consent, Applicant has disclosed such communications. *See* Exhibits 3 and 4 to Extension Request Opposition. Accordingly, Opposer requests that the Board substitute redacted versions of those exhibits (attached hereto as Exhibit A) in lieu of the exhibits attached to the Extension Request Opposition.

1. Good Cause Supports Extension Request

Prior to the filing of the Extension Request, the parties had been discussing settlement (first of Applicant's pending Second Motion to Amend, then of the proceeding as a whole), and during this time had agreed to a number of extensions of the deadline for Opposer to respond to the Second Motion to Amend. Additionally, in the course of these proceedings, Applicant's counsel's comments indicated that he was amenable to consent to extension requests, as an expression of "regular courtesies", to avoid "actual inconvenience to anyone" and even to a short extension when it was unclear how Applicant would receive a longer extension request.

For example, while Applicant wanted to keep the case moving, "though not at the expense of regular courtesies or actual inconvenience to anyone". *See* Exhibit 2 to Extension Request Opposition. Moreover, in one recent instance, when Applicant's counsel was unsure how Applicant would respond to Opposer's request for a thirty (30) day extension, counsel advised that Opposer can "count on some extension to accommodate this." *See* February 5, 2010 email string, attached hereto as Exhibit B.² Furthermore, the Extension Request Opposition does not state (and Applicant's exhibits do not show) that Applicant ever notified Opposer that it would not consent to further extensions – that is, until the business day before Opposer's brief was due.³

² Applicant eventually consented to the full thirty (30) day extension request.

³ Applicant states that Opposer's "deadline to answer was extended to February 7, 2010, with Applicant's understanding that all transactions needed to consummate settlement of the entire case would occur before then." *See* Applicant's Extension Opposition, p.2. Significantly, Applicant's Brief does not cite any email or other communication to support this contention. More to the point, such an (uncommunicated) belief was objectively unreasonable since, at the time the extension was filed on January 7, 2010, no settlement proposal had even been offered by either side.

Indeed, as late as March 3, 2010, Applicant was still inviting a settlement response by, *at least*, the end of that week (*i.e.*, March 5, 2010), *without* stating that it would not consent to any further extensions. *See* March 3, 2010 email string, attached hereto as Exhibit C. Opposer's proposal was tendered two business days later.⁴

Accordingly, Opposer reasonably believed that Applicant would consent to the extension request which accompanied Opposer's settlement proposal. However, after receiving Opposer's settlement proposal, Applicant departed from this pattern by declining Opposer's requests for Applicant's consent to a further extension of the deadline – requests which were tendered before and after Applicant's rejection of Opposer's settlement proposal.

Moreover, Applicant communicated its decision on the last business day before the deadline – a day Opposer's counsel was out of the office. At a minimum, Opposer would have expected Applicant to consent to a final, short extension to allow it time to turn to the response. *See e.g.*, Exhibit 2 to Extension Request Opposition, and attached Exhibit B.

Opposer believes that the circumstances described in these various papers adequately demonstrate good cause for a one week extension request.

⁴ Additionally, it would appear that even if Opposer agreed with Applicant's proposal by March 5, 2010, a further extension would almost assuredly have had to be filed (in order to craft and negotiate *specific* settlement terms, and have the agreement executed) suggesting that Applicant's consent was tied to the perceived quality of Opposer's settlement proposal. As expressed by Applicant, it was displeased with Opposer's proposal because the communication was not "styled 'counterproposal'", was deemed by Applicant not to be responsive to Applicant's proposal, and "did not refer to or acknowledge Applicant's settlement proposal at all, despite the effort Applicant had put into its settlement proposal" (emphasis supplied).

2. Opposer Was Diligent.

The Extension Request Opposition seeks to cast Opposer as not being diligent. However, these assertions are readily contradicted by Applicant's own exhibits. For example, Applicant asserts that Opposer "wait[ed] until the last extended day (the last day was on a Sunday, the Motion to Extend was made on the following Monday) to seek an extension." *See* Extension Request Opposition, p. 8. Applicant is wrong. Opposer sought Applicant's consent to an extension *at the same time* it proffered its settlement proposal on March 9, 2010. *See* Exhibit 4 to Extension Request Opposition, Opposer's March 9, 2010 email ("In the meantime, we suggest a thirty (30) day extension of the current deadline").⁵ It is noted that Applicant did not respond to Opposer's request for consent to the extension when it was made, or even when Applicant rejected Opposer's settlement proposal. Rather, Opposer had to ask a second time.

Moreover, Applicant asserts that: "In fact, Applicant's extensive written settlement initiative of January 14 was not 'acknowledged' until March 9". *See* Extension Request Opposition, p.5. Again, Applicant is wrong, as demonstrated by Applicant's own exhibits: in fact, as early as February 5, 2010 (the beginning of a large snow storm which closed the PTO for nearly one week), Opposer "acknowledged" the proposal. *See* Extension Request Opposition, Exhibit 4, p. 4, February 5 email ("We had hoped to provide a response to your client's settlement proposal by this time."). Moreover, Opposer advised Applicant on March 3, 2010, that it had received instructions,

⁵ Moreover, the last day of the extended period was March 15, 2010 (a Monday), since March 14, 2010 fell on a Sunday. Thus, even by Applicant's incorrect reckoning, Opposer's (second) request for Applicant's consent to a further extension on March 12, 2010 (which Applicant treats as Opposer's first request for an extension) was not on the last extended day.

that a further clarification was required, and it expected to be in a position to respond in a few days. *See* Exhibit C. Opposer proffered its proposal on March 9, 2010.

Finally, Opposer promptly filed the Extension Request. Applicant first advised Opposer on March 12, 2010 that it would not consent to a further extension. *See* Exhibit 4. However, Opposer's counsel was out of the office that day. *Id.* Accordingly, the Extension Request was filed on the next business day.

3. Applicant Has Not Demonstrated Any Prejudice

Applicant fails to establish any prejudice resulting from a **one week** "delay" of the proceeding. Indeed, Applicant does not even contend that there is any prejudice resulting from a grant of the Extension Request. Rather, in a single sentence, the Extension Request Opposition asserts, more broadly, that Applicant is being prejudiced "by the delay in resolving this proceeding". *See* Extension Request Opposition, p.8, and the attached declaration.

Of course, there is no factual or legal basis to support a finding of prejudice resulting from a one week delay – especially in view of the above circumstances. Indeed, a much longer delay of the proceeding – seven (7) weeks (from October 2, 2009 to November 20, 2009) – was occasioned by Applicant's failure to properly seek to amend its pleadings. *See* Board's November 5, 2010 Order.⁶ Accordingly, Applicant should not be heard to complain about a one week "delay", especially under the present circumstances.

⁶ Moreover, Applicant's failure to serve Opposer with a complete filing occasioned a five (5) day delay. *See* October 7, 2010 Amended Certificate of Service.

Moreover, Opposer would be prejudiced if the Extension Request is not granted (and Opposer's response to the Second Motion to Amend not considered) since Opposer then may have to respond to facially deficient pleadings. *See* Opposer's response to Second Motion to Amend.

4. No Evidence of Bad Faith or an Abuse of the privilege of Extensions

There is no evidence of bad faith on the part of Opposer in seeking the extension request.

Moreover, while Opposer has filed other extension requests, those were filed pursuant to Applicant's express consent. The Extension Request constitutes the first *unconsented* extension request that Opposer filed. Furthermore, the Extension Request is for a very short period, namely, one week. Upon the expiration of the deadline set forth in the one week Extension Request, Opposer filed its Brief in response to the Second Motion to Amend. Accordingly, Opposer has not abused the privilege of seeking extensions.

Conclusion

For all of the reasons discussed in the various briefs, Opposer respectfully requests the Board to grant Opposer's request for a one week extension.

Respectfully submitted,

LA SENZA CORP.

By: /MJC/
George W. Lewis
Matthew J. Cuccias
JACOBSON HOLMAN, PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004
(202) 638-6666
Attorneys for Opposer

April 12, 2010

CERTIFICATE OF SERVICE

I hereby certify that on this 12th day of April, 2010, a true copy of the foregoing paper was served by first-class mail, postage prepaid, upon counsel for Applicant:

Philip A. Kantor, Esq.
Law Offices of Philip A. Kantor, P.C.
1781 Village Center Circle, Suite 120
Las Vegas, Nevada 89134

/MJC/

Exhibit A

EXHIBIT 3

Law Offices of
PHILIP A. KANTOR

Professional Corporation
Suite 120
1781 Village Center Circle
Las Vegas, Nevada 89134

Admitted in Nevada and New York
Email: prsak@aya.yale.edu

Telephone: (702) 255-1300
Telefax: (702) 256-6331

January 14, 2010

Via email: mcuccias@jhip.com

Jacobson Holman PLLC
Attn.: Matthew J. Cuccias, Esq.
400 Seventh Street NW
Washington, DC 20004

Re: *La Senza Corp. v. Olympic Mountain*
TTAB Opp. No. 91185325

Dear Matthew:

I am pleased to provide you with our thoughts on settling the referenced opposition proceeding.

REDACTED

Mr. Matthew Cuccias, Esq.
January 14, 2010
Page 2

REDACTED

Mr. Matthew Cuccias, Esq.
January 14, 2010
Page 3

REDACTED

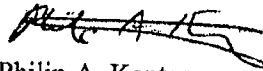
Mr. Matthew Cuccias, Esq.
January 14, 2010
Page 4

REDACTED

Mr. Matthew Cuccias, Esq.
January 14, 2010
Page 5

Thank you for your consideration. Please reply next week.

Very truly yours,

A handwritten signature in dark ink, appearing to read "Philip A. Kantor", with a stylized flourish at the end.

Philip A. Kantor

EXHIBIT 4

Philip A. Kantor

From: Philip A. Kantor [prsak@aya.yale.edu]
Sent: Friday, March 12, 2010 12:09 PM
To: 'Matthew Cuccias'
Cc: 'olympic.trademark@trustifi.com'
Subject: RE: Opposition No. 91185325 - La Senza Corporation v. Olympic Mountain and Marine Products, Inc. (JH Ref. No. I-5837)

Dear Matthew: I am always willing to talk. I can't give a further extension, unfortunately, as the client doesn't want to do it, and my authority to do so is now limited. This is why I so much wanted to get an earlier response from you, so that we could still have some back and forth within the long extension last time. Anyway, I see no problem having a dialogue while the Board decides the pending motion, so you are certainly free to call. I will be with a client from England all day Monday.

As ever,

Philip

From: Matthew Cuccias [mailto:mcuccias@jhip.com]
Sent: Friday, March 12, 2010 11:53 AM
To: prsak@aya.yale.edu
Cc: olympic.trademark@trustifi.com; Matthew Cuccias
Subject: RE: Opposition No. 91185325 - La Senza Corporation v. Olympic Mountain and Marine Products, Inc. (JH Ref. No. I-5837)

Dear Philip:

In view of your below email (which I found surprising), it may be useful to chat about the various proposals; and suggest we do so early next week (presently, I am out of the office).

In the meantime, we request an extension of the pending deadline.

Sincerely,

Matthew J. Cuccias, Esquire



400 Seventh Street, N.W.
Washington, DC 20004
phone: 202-638-6666 x2260
email: mcuccias@jhip.com



Please consider the environment before printing this e-mail.

3/19/2010

From: Philip A. Kantor [prsak@aya.yale.edu]
Sent: Friday, March 12, 2010 12:35 PM
To: Matthew Cuccias
Cc: olympic.trademark@trustifi.com
Subject: RE: Opposition No. 91185325 - La Senza Corporation v. Olympic Mountain and Marine Products, Inc. (JH Ref. No. I-5837)

Dear Matthew:

I do not feel the email below was responsive to my long and detailed letter to you regarding settlement. It does not refer in any way to what I wrote, or even acknowledge that I wrote at all. Nevertheless, I forwarded it to my client. The client's take was the same: this does not seem to be a dialogue. Have a good weekend.

As ever,

Philip

From: Matthew Cuccias [mailto:mcuccias@jhip.com]
Sent: Tuesday, March 09, 2010 8:38 AM
To: prsak@aya.yale.edu
Cc: George Lewis; Matthew Cuccias
Subject: Opposition No. 91185325 - La Senza Corporation v. Olympic Mountain and Marine Products, Inc. (JH Ref. No. I-5837)

Dear Phil:

Our client is amenable to an amicable resolution on the following general grounds:

REDACTED

If these terms are agreeable to Olympic, we can prepare a written agreement embodying these and other, standard terms.

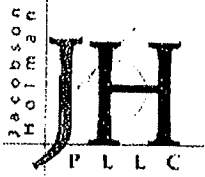
We look forward to your response. In the meantime, we suggest a thirty (30) day extension of the current deadline.

Sincerely,

Matthew

Matthew J. Cuccias, Esquire

3/19/2010



400 7th Street, NW
Washington, DC 20004
phone: 202-638-6666 x2260
email: mcuccias@jhip.com



Please consider the environment before printing this e-mail.

-----Original Message-----

From: Matthew Cuccias

Sent: Thursday, February 11, 2010 11:25 AM

To: prsak@aya.yale.edu

Cc: George Lewis; Matthew Cuccias

Subject: RE: Opposition No. 91185325 - La Senza Corporation v. Olympic Mountain and Marine Products, Inc. (JH Ref. No. I-5837)

Dear Philip:

Thank you for your below email.

I am not sure what you mean by an "informal condition". If you mean that we will use "best efforts", I am comfortable with that. However, I am not comfortable guaranteeing the future actions of my client.

Also, as you may know, we have experienced record snowfalls in the Washington, D.C.-area, resulting in the localized closure of the Federal Government. Thus, I have not been in the office since Friday afternoon. Moreover, while I have email access from home -- it has been intermittent (our email server just came back online).

Accordingly, I propose that the "informal condition" be that we make best efforts to obtain a response in two weeks from now.

Since the government has been closed, the deadline to respond has been extended by operation of the rules. I am hopeful that the government will be open tomorrow, and would like to file the request then.

Sincerely,

Matthew J. Cuccias, Esquire



400 Seventh Street, N.W.
Washington, DC 20004
phone: 202-638-6666 x2260
email: mcuccias@jhip.com



Please consider the environment before printing this e-mail.

3/19/2010

From: Philip A. Kantor [prsak@aya.yale.edu]
Sent: Monday, February 08, 2010 3:49 PM
To: Matthew Cuccias
Subject: RE: Opposition No. 91185325 - La Senza Corporation v. Olympic Mountain and Marine Products, Inc. (JH Ref. No. I-5837)

Dear Matthew:

I just got off the phone with my client. It took a little work, but I persuaded the client to go along with the following plan: Olympic Mountain will consent to an additional thirty days, but on the informal condition that La Senza get back to us on settlement within two weeks, so that there is a meaningful chance to settle the whole case, after back-and-forth, within the thirty days. OK?

Hope you had fun in the snow!

As ever,

Philip

From: Matthew Cuccias [mailto:mcuccias@jhip.com]
Sent: Friday, February 05, 2010 9:06 AM
To: 'prsak@aya.yale.edu'
Cc: Matthew Cuccias; George Lewis
Subject: Opposition No. 91185325 - La Senza Corporation v. Olympic Mountain and Marine Products, Inc. (JH Ref. No. I-5837)

Dear Philip:

We had hoped to provide a response to your client's settlement proposal by this time. However, we are not now in such a position.

To allow for the prospect of an amicable resolution of this matter, we seek your consent to a thirty (30) day extension of time and service by email.

In view of the schedule (and the current snow storm in D.C.), we would appreciate receiving your consent today.

Thank you.

Sincerely,

Matthew J. Cuccias, Esquire



400 7th Street, NW
Washington, DC 20004

3/19/2010

phone: 202-638-6666 x2260
email: mcuccias@jhip.com

Page 5 of 5



Please consider the environment before printing this e-mail.

3/19/2010

Exhibit B

Matthew Cuccias

From: Philip A. Kantor [prsak@aya.yale.edu]
Sent: Friday, February 05, 2010 3:07 PM
To: Matthew Cuccias
Subject: RE: Opposition No. 91185325 - La Senza Corporation v. Olympic Mountain and Marine Products, Inc. (JH Ref. No. I-5837)

Just letting you know that I haven't heard back from my client yet. Let's see what happens Monday. I can't promise my client will want to extend for thirty days, but for my part, you may certainly not worry about doing anything this weekend, and count on some extension to accommodate this. So, enjoy the snow, and we'll touch base next week. Philip

From: Matthew Cuccias [mailto:mcuccias@jhip.com]
Sent: Friday, February 05, 2010 9:06 AM
To: 'prsak@aya.yale.edu'
Cc: Matthew Cuccias; George Lewis
Subject: Opposition No. 91185325 - La Senza Corporation v. Olympic Mountain and Marine Products, Inc. (JH Ref. No. I-5837)

Dear Philip:

We had hoped to provide a response to your client's settlement proposal by this time. However, we are not now in such a position.

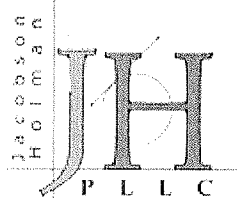
To allow for the prospect of an amicable resolution of this matter, we seek your consent to a thirty (30) day extension of time and service by email.

In view of the schedule (and the current snow storm in D.C.), we would appreciate receiving your consent today.

Thank you.

Sincerely,

Matthew J. Cuccias, Esquire



400 7th Street, NW
Washington, DC 20004
phone: 202-638-6666 x2260
email: mcuccias@jhip.com



Please consider the environment before printing this e-mail.

4/12/2010

Exhibit C

Matthew Cuccias

From: Philip A. Kantor [prsak@aya.yale.edu]
Sent: Wednesday, March 03, 2010 7:46 PM
To: Matthew Cuccias
Subject: RE: Opposition No. 91185325 - La Senza Corporation v. Olympic Mountain and Marine Products, Inc. (JH Ref. No. I-5837)

Good, please make it this week. Thanks. Philip

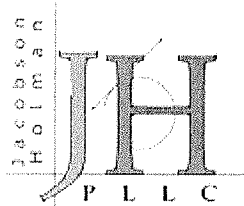
From: Matthew Cuccias [mailto:mcuccias@jhip.com]
Sent: Wednesday, March 03, 2010 4:00 PM
To: 'prsak@aya.yale.edu'
Cc: Matthew Cuccias
Subject: RE: Opposition No. 91185325 - La Senza Corporation v. Olympic Mountain and Marine Products, Inc. (JH Ref. No. I-5837)

Dear Phil:

We have received settlement instructions from the client, but need to clarify a term. We hope to be able to send you the proposal in the next few days.

Sincerely,

Matthew J. Cuccias, Esquire



400 7th Street, NW
Washington, DC 20004
phone: 202-638-6666 x2260
email: mcuccias@jhip.com



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4/12/2010